

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Gregory A. Hodge
and Bennie L. Gibson**

Confirmation No.: **5021**

Serial No.: **09/866,765**

Group Art Unit: **2421**

Filing Date: **May 30, 2001**

Examiner: **Christopher L. Parry**

For: **METHODS AND APPARATUS FOR INTERACTIVE TELEVISION**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPELLANT'S REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Appellants submit this Reply in response to the Examiner's Answer dated August 31, 2009 in connection with the above-identified application. This Reply is being filed within two months of the Answer.

The Answer responded to Appellants' arguments with respect to claims 44 and 48. Appellants presently reply to each of the arguments in the Answer, and reassert their appeal of claims 44-115.

Claim 44

Claim 44 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Broadwin, U.S. Patent No. 5,903,816 ("Broadwin"). Claim 44 recites receiving (1) an interactive icon, (2) a first content, and (3) a video signal including a second content. Further, claim 44 recites generating instructions to configure a set-top box (1) to overlay the received interactive icon on the received second content, and (2) to display the received first content if the received interactive icon is selected:

receiving an electronic file, wherein the electronic file includes
an interactive icon and first content;

receiving a video signal including second content;

generating instructions for a set-top box, wherein the instructions
for the set-top box configure the set-top box to overlay the interactive
icon in the electronic file on at least a portion of the second content in
the video signal and the instructions for the set-top box configure the

set-top box to display the first content if the interactive icon is selected;

combining the video signal, the instructions for the set-top box, and the electronic file together to form a first channel;

combining the first channel with a second channel to form a broadcast signal; and

transmitting the broadcast signal to the set-top box.

As recited in claim 44, the interactive icon, the first content and the second content are received. Further, instructions for a set-top box are generated based on the received interactive icon, first content and second content. The instructions are combined with the video signal and the electronic file to form a first channel, and the first channel is combined with a second channel to form a broadcast signal. The broadcast signal is then transmitted to the set-top box. See Appeal Brief, Fig. A, page 10 (depicting a non-limiting graphical representation of the method of claim 44). Thus, the instructions for the set-top box are generated based on the received interactive icon, first content and second content, and then the instructions and the received interactive icon, first content and second content are transmitted to the set-top box as part of the broadcast signal.

The Answer appears to argue both that that Broadwin explicitly anticipates claim 44, Answer, pages 14-15, and that Broadwin inherently anticipates claim 44, Answer, pages 15-17. Appellants respectfully disagree with both conclusions for the reasons discussed below. These assertions by the Answer are discussed in turn.

First, Appellants submit that the Answer errs in its finding that Claim 44 is expressly anticipated by Broadwin. The law on express anticipation is clear: “[a] claim is anticipated [express] *only if each and every element* as set forth in the claim is found...described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814, F.2d 628, 631 (Fed. Cir. 1987) (emphasis added). The Answer indicates that Broadwin teaches an application server 104 which generates interactive content including application code or “instructions”. Answer, page 14 (citing Broadwin, col. 5, ll. 1-6). The Answer further cites to Broadwin as teaching a CPU 314 of decoder 140 which “uses the received application code of ‘instructions’ to cause one or more selection buttons or ‘interactive icons’ to be overlaid on top of a television program or ‘second content’.” Answer, page 14 (citing Broadwin, col. 7, ll. 46-53 and col. 2, ll. 48-67). Appellants note that Broadwin’s element 140 is described as “a set top box or decoder 140.” Broadwin, col. 5, line 39. The Answer then concludes that “Broadwin clearly teaches that the processor within decoder [set top box]

140 uses the received application data to facilitate overlaying the selection buttons or ‘interactive icons’ on the received audio visual content or ‘second content’.” Answer, page 14.

Appellants understand the Answer to argue that the “generating instructions for a set-top box” recitation of claim 44 is taught by application server 104 generating application code. Appellants further understand the Answer to argue that the “receiving an electronic file...includ[ing] an interactive icon and first content” and “receiving a video signal including second content” recitations of claim 44 are taught by Broadwin’s decoder set top box 140 receiving content. According to this understanding, Appellants respectfully submit that Broadwin fails to teach or suggest the recitations of claim 44. In contrast to Broadwin’s teachings, claim 44 recites that the instructions for the set-top box are generated based on the received interactive icon, first content and second content, and then the generated instructions and the received interactive icon, first content and second content are transmitted to the set-top box as part of the broadcast signal. More specifically, if it is Broadwin’s set top box 140 which receives the interactive icon, first content and second content, it is not possible for the application server 104 to transmit a broadcast signal to the set to box 140 which includes the received interactive icon, first content and second content, together with the generated instructions.

Appellants respectfully submit that the arguments in the Answer fail to show any way in which Broadwin expressly teaches each and every element set forth in claim 44. Further, the other cited portions of Broadwin do not cure this failure to expressly teach each and every element set forth in claim 44. Thus, Appellants submit that Broadwin fails to expressly anticipate claim 44.

Second, Appellants submit that the Answer errs in its finding that Claim 44 is inherently anticipated by Broadwin. When a reference does not expressly describe a recitation of the claim, the recitation may be found to inherently describe the recitation if the missing descriptive material is “necessarily present.” *Continental Can Co. v. Monsanto Co.*, 20 U.S.P.Q.2d 1749, 1749 (Fed. Cir. 1991). However, inherency may **not** be established by probability or possibility; “[t]he mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.” *Trintec Industries Inc. v. Top-U.S.A. Corp.*, 63 U.S.P.Q.2d 1597, 1599 (Fed. Cir. 2002).

As noted in the Answer, Broadwin’s application server 104 is “configured for generating or providing ‘OpenTV’ interactive applications.” Broadwin, col. 5, ll. 6-10. The

Answer concludes from this that it is “a prerequisite for application server 104 to receive beforehand the interactive program applications or ‘electronic files’ from a source, such as an advertiser or vendor, in order to facilitate distributing interactive applications that enables the user to order a product.” Appellants respectfully traverse the conclusion that it is a “prerequisite” for another source to provide Broadwin’s application server 104 with interactive program files. To the contrary, Broadwin specifically states that the application server is “configured for *generating*...interactive applications.” Broadwin, col. 5, ll. 6-10. Because Broadwin explicitly teaches that the application server 104 can generate interactive content, Appellant respectfully submits that it is not a “prerequisite for application server 104 to receive beforehand the interactive program applications...from a source,” as asserted by the Answer.

In an effort to further bolster its position, the Answer, without citing to Broadwin, states: “*Typically* the advertiser or vendor of the product will provide the interactive content directly to a broadcaster to facilitate generating new business and increased sales of the product.” Answer, page 16 (emphasis added). From this assertion, the Answer concludes that Broadwin teaches that application server 104 receives content from an advertiser or a vendor of a product. *Id.* As the Answer does not cite to Broadwin, Appellant submits that Broadwin fails to explicitly teach the application server 104 receiving content from an advertiser or vendor. Further, Appellants submit that Broadwin does not inherently anticipate receiving content from an advertiser or a vendor because that is not necessarily present in Broadwin. Even assuming, *arguendo*, that content is typically provided to Broadwin’s application server 104, the content is not necessarily provided to application server 104 because application server 104 generates content. Because inherency may not be established by probability or possibility, Appellants submit that Broadwin fails to inherently teach that application server 104 receives content from an advertiser or vendor.

For the foregoing reasons, Appellants respectfully submit that Broadwin fails to anticipate, expressly or inherently, claim 44. Accordingly, Appellants respectfully request reversal of the rejection of claim 44 under 35 U.S.C. § 102(b).

Claim 48

Claim 48 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Broadwin. Claim 48 recites that “the first content includes a purchasing screen for purchasing the product on at least a portion of the second content in the video signal.” As recited, the

purchasing screen is on at least a portion of the second content in the video signal. In addition to depending on claim 44 which is patentably defined over Broadwin, Appellants submit that claim 48 is patentably defined over Broadwin for the following reasons.

The Answer argues that Broadwin teaches still images broadcast to a user in a broadcast channel, where the still images are associated with interactive program content. Answer, page 16. The Answer then cites to Broadwin as teaching that the user can selectively navigate between the video content and stills in a web-like hyperlinked fashion. *Id.* (citing Broadwin, col. 2, ll. 48-67). Even assuming, *arguendo*, that Broadwin teaches a web-link hyperlinked interface by which the user can navigate between the video content and the stills, Appellants are unable to discern how navigating between video content and interactive content teaches placing a purchase screen on a portion of content in a video signal. To the contrary, Broadwin's need to switch between the interactive image still and the video signal indicates that Broadwin fails to teach a purchase screen on a portion of video content.

For the foregoing reasons, Appellants submit that the reasoning set forth in the Answer fails to support the rejection of claim 44 as being anticipated by Broadwin. Accordingly, Appellants respectfully request reversal of the rejection of claim 48 under 35 U.S.C. § 102(b).

All claims

Appellants persist in their appeal of all claims pending in the present case. The section of the Answer labeled "Response to Argument" addresses only claims 44 and 48. Answer, pages 14-18. Appellants' present Reply addresses the arguments set forth in the Answer. Thus, Appellants' arguments above are directed only to claims 44 and 48. However, Appellants reassert that claims 45-47 and 49-115 are patentably defined over the cited art for the reasons set forth in the Appeal Brief. Accordingly, Appellants request reversal of the rejections of claims 45-47 and 49-115.

Conclusion

For the foregoing reasons, Appellants respectfully submit that the cited portions of Broadwin fail to anticipate claims 44, 53, 62, 77, 92, and 101. Appellants further submit that the cited portions of Broadwin fail to anticipate claims 48, 57, 67, 82, 96, and 106. Further, the rejections of dependent claims 45-52, 54-61, 63-76, 78-91, 93-100, and 102-115 rely on the rejection using Broadwin to anticipate the independent claims. Accordingly, applicants

submit that claims 44-115 are patentably defined over the cited art, and respectfully request reversal of the examiner's rejections of claims 44-115.

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